REMARKS

Applicant has carefully reviewed the Application in light of the Advisory Action mailed March 29, 2004. At the time of the Advisory Action, Claims 1-10, 14-17, and 21-24 were pending in the Application. Applicant cancels these claims without prejudice or disclaimer. The cancellation of these claims is not the result of any prior art reference, nor has it been done to address any potential deficiency in Applicant's specification. The cancellation of these claims has been done only in an effort to expedite the prosecution of this case. Applicant also adds claims 36-46. The addition of these claims does not add any new matter to the Application. In addition, Applicant has made a series of minor corrections to the specification because of various inaccuracies, which were identified by the Examiner. No new matter has been added to the Application. For the convenience of the Examiner, Applicant has appended a marked-up copy and a clean copy of the specification (reflecting these changes) to this Response. Applicant respectfully requests reconsideration of the pending claims and favorable action in this case.

Priority

The Examiner notes that Applicant has submitted an uncertified copy of the 99112552.7 Application filed in Europe on July 1, 1999 and requests that a certified copy be submitted as is required by 35 U.S.C. 119(b). Because any reference to this application has been removed, Applicant has fully addressed this matter and overcome the objection. The Examiner also notes that Applicant has submitted an uncertified copy of the 01-11594.8 Application filed in Europe on May 31, 2000 and requests that a certified copy also be submitted as is required by 35 U.S.C. 119(b). Applicant has complied with the Examiner's request and provided the certified document, which is appended to this Response.

Claim Objections

The Examiner made numerous objections to the Claims: specifically identifying a number of typographical errors. Applicant again apologizes for these drafting imperfections. Applicant has Canceled the previously pending claims and proffered the new claim set.

Section 102 Rejections

The Examiner provisionally previously rejected Claims 1-6, 9-10, 14-15, and 21-24 under 35 U.S.C. §102(e) as being anticipated by copending Application 09/608,657, which has a

common inventor and a common assignee with the instant application. This rejection is now moot in light of the cancellation of those claims and the addition of claims 36-46. The addition of these Claims is a result of multiple conversations between Applicant and Examiner Kim, who is handling this matter. The resultant claim strategy was developed with exceptional cooperation from the participating parties. Accordingly, Applicant is confident in the patentability of the pending claims.

Section 103 Rejections

The Examiner rejects claims 1, 3-4, 9-10, 14-15, and 22 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,647,035 issued to Cadeddu et al. (hereinafter "*Cadeddu*") in view of Gerstel et al. (article entitled "Optical layer survivability: a services perspective") (hereinafter "*Gerstel*"). The Examiner rejects claims 1-5, 7-10, 14-17, and 21-22 under 35 U.S.C. §103(a) as being unpatentable over European Patent Application EP 920153 A2 (hereinafter "*Shiragaki*") in view of *Cadeddu*. The Examiner rejects claims 6 and 24 under 35 U.S.C. §103(a) as being unpatentable over *Shiragaki et al.* in view of *Cadeddu* as applied to Claims 5 and 14 and, further, in view of *Karasan et al.* (article entitled "Optical restoration at the wavelength-multiplex-section level in WDM mesh networks"). The Examiner also rejects claims 11-13 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,259,837 issued to de Boer et al. (hereinafter "*de Boer*") in view of *Cadeddu* (as applied to Claim 3 above under 35 U.S.C. §102(b)). The Examiner also rejects Claims 11-13 under 35 U.S.C. §103(a) as being unpatentable over *de Boer* in view of *Shiragaki, et al.* and in view of *Cadeddu* (as applied to Claim 3 above under 35 U.S.C. §103(a)). The Examiner also rejects Claims 25-35 under 35 U.S.C. §103(a) as being unpatentable over *Shiragaki, et al.* in view of *Karasan, et al.* With respect to the previous §103 rejections, Applicant has canceled those rejected claims. Applicant proffers that the new claims are patentable over the references, which were used to support the §103 rejections based on previous discussions with Examiner Kim.

Double Patenting and Provisional Rejections

The Examiner provisionally previously rejected claims 1-6, 9, 14-15, and 21-22 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 and 14-21 of copending Application No. 09/608,657 in view of *Gerstel*. This rejection is now moot in light of the cancellation of those claims. Applicant respectfully submits

that the newly added claims are patentably distinct from the copending application. Accordingly, Applicant has overcome the double patenting rejection.
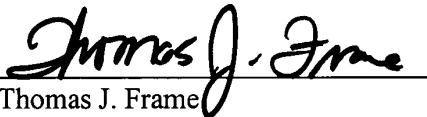
20

CONCLUSION

Applicant has now made an earnest attempt to place this case in condition for immediate allowance. For the foregoing reasons and for other reasons clear and apparent, Applicant respectfully requests reconsideration and allowance of the pending claims.

Applicant submits herewith a check in the amount of $770.00 to satisfy the request for continued examination fee of 37 C.F.R. §1.17(e). If this is not correct, the Commissioner is hereby authorized to charge any fees or credit any overpayment to Deposit Account No. 02-0384 of Baker Botts, L.L.P.

If there are matters that can be discussed by telephone to advance prosecution of this application, Applicants invite the Examiner to contact its attorney at the number provided below.

Respectfully submitted,

Baker Botts L.L.P.
Attorneys for Applicant

Thomas J. Frame
Reg. No. 47,232

Date April 16th, 2004

CORRESPONDENCE ADDRESS:

2001 Ross Avenue, Suite 600
Dallas, TX 75201-2980
(214) 953-6675
(213) 661-4675

05073

Patent Trademark Office